

### **REMARKS/ARGUMENTS**

In response to the Office Action mailed October 15, 2008, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, Claims 1, 12, 21 and 31 are amended, no new claims have been added and no claims have been cancelled without prejudice so that Claims 1-23 and 25-54 remain pending. No new matter has been introduced.

Claims 1, 12, 21 and 31 were rejected under 35 U.S.C. §112, second paragraph. Accordingly, Applicants have amended these claims to more clearly set forth the inventions. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-6, 9-14, 17-23 and 28 were rejected as being anticipated by U.S. Patent Application No. 2001/0031943 to Urie (Urie). This rejection is respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

Urie discloses an apparatus for the treatment of tissue that comprises a wound dressing which has a porous layer for contacting a wound site and a lumen tube which includes at least first and second conduits. Overlying an outer surface of the sponge layer is a non-porous covering.

Urie fails to disclose the device of the amended independent claims. More specifically, Urie fails to disclose an unobstructed porous element or one that make flush juxtaposition with the target site. In fact, Urie discloses a layer overlaying the sponge. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 7-8, 15-16 and 29-30 were rejected as being unpatentable over Urie in view of U.S. Patent No. 5,997,497 to Nita et al. (Nita). Claims 25-27 and 31-34 were rejected as being unpatentable over Urie in view of Nita and further in view of U.S. Patent no. 5,916,193 to Stevens et al. (Stevens).

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d,488,20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).”

Nita discloses an ultrasound catheter.

Stevens discloses a venting catheter, system and method that are provided for withdrawing blood and other fluids from a patient's heart to facilitate decompressing the heart during cardioplegic arrest and cardiopulmonary bypass, without the need for a thoracotomy and without puncturing the aorta, pulmonary artery, or heart itself. The venting catheter is configured to be introduced into a peripheral vein and intraluminally advanced through the right side of the heart and into the pulmonary artery. The venting catheter includes a lumen configured to withdraw blood at a rate of at least about 50 ml/min at a pressure of no less than about -350 mmHg. A flow-directing means is provided to facilitate guiding the catheter into the pulmonary artery by being carried by blood flow through the heart.

None of the references, whether taken alone or in combination disclose the subject matter of amended independent claims 1, 12, 21 and 31 as is explained above. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

/Carl J. Evens/  
By: \_\_\_\_\_  
Carl J. Evens  
Reg. No. 33,874

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-2518  
Dated: January 12, 2009